

Notice of Allowability

Application No.

09/325,536

Applicant(s)

BOYLE ET AL.

Examiner

Art Unit

Forest Thompson Jr.

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 05/24/2004.
2. ☒ The allowed claim(s) is/are 1-3, 5-15 and 17-39.
3. ☒ The drawings filed on 04 June 1999 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☐ All b) ☐ Some* c) ☐ None of the:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☒ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☒ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☒ to Paper No./Mail Date 08/28/2000.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date 5/24/04
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date _____
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

DETAILED ACTION

1. **Claims 1-3, 5-15, and 17-39 are allowed.**
2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/24/2004 has been entered.
3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action (See Paper No. 4). The text of those sections of Title 35, U.S. Code not otherwise provided in a prior Office action will be included in this action where appropriate.
4. This action is responsive to the amendment filed 05/24/2004. The amendment canceled claim 16, amended claims 1-3, 5, 8, 12-13, 17, 20-21, 23, and 26-27, and added new claims 29-39. Claim 4 was previously cancelled in amendment C filed 17 March 2003. Claims 1-3, 5-15, and 17-39 are pending.
5. Claims 1-3, 5-15, and 17-39 have been examined.

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6. Claims 1-3 and 27 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holmann (U.S. Patent No. 5,787,404), and further in view of Kolling et al. (U.S. Patent No. 5,920,847), Pollin (U.S. Patent No. 6,041,315), Perazza (U.S. Patent No. 5,326,959), and Auriemma (U.S. Patent No. 5,513,102). Applicants' amendment and arguments overcame the rejection; therefore, examiner withdraws the rejection.

7. Claim 8-12 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holmann (U.S. Patent No. 5,787,404), and further in view of Reeder (U.S. Patent No. 6,014,636), Kolling et al. (U.S. Patent No. 5,920,847), Auriemma (U.S. Patent No. 5,513,102), and Official notice. Applicants' amendment and arguments overcame the rejection; therefore, examiner withdraws the rejection.

8. Claims 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. (U.S. Patent No. 5,920,847), and further in view of Auriemma (U.S. Patent No. 5,513,102). Applicants' amendment and arguments overcame the rejection; therefore, examiner withdraws the rejection.

9. Claims 14-15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. (U.S. Patent No. 5,920,847), and further in view of Auriemma (U.S. Patent No. 5,513,102), and OFFICIAL NOTICE. Applicants' amendment

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and arguments overcame the rejection; therefore, examiner withdraws the rejection.

10. Claim 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. (U.S. Patent No. 5,920,847), and further in view of Fernandez-Holmann (U.S. Patent No. 5,787,404), Auriemma (U.S. Patent No. 5,513,102), and OFFICIAL NOTICE. Applicants' amendment and arguments overcame the rejection; therefore, examiner withdraws the rejection.

11. Claims 21-25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al. (U.S. Patent No. 5,920,847), and further in view of Fernandez-Holmann (U.S. Patent No. 5,787,404), Pollin (U.S. Patent No. 6,041,315), Perazza (U.S. Patent No. 5,326,959), and Auriemma (U.S. Patent No. 5,513,102). Applicants' amendment and arguments overcame the rejection; therefore, examiner withdraws the rejection.

12. Claims 26 was rejected under 35 U.S.C. 103(a) as being unpatentable over Fernandez-Holmann (U.S. Patent No. 5,787,404), and further in view of Kolling et al. (U.S. Patent No. 5,920,847), Pollin (U.S. Patent No. 6,041,315), Perazza (U.S. Patent No. 5,326,959), Auriemma (U.S. Patent No. 5,513,102) and Official Notice. Applicants' amendment and arguments overcame the rejection; therefore, examiner withdraws the rejection.

Reasons for Allowance

13. The following is an examiner's statement of reasons for allowance:

The instant invention relates to a novel and unobvious apparatus and method for a card that allows a cardholder to set up autocharge payment of dues and fees to a series of clubs, merchants, or service providers, and for other transactions that accept credit cards. Key elements, which are in all independent claims (claims 1, 5, 13, 17, 21) and disclosed by prior art, are a credit card for charging point of sale transactions, a database of transaction information, a card issuer, a card processor, and a credit card associated with a predetermined network and issuer. However, prior art does not disclose the additional key elements identified below, as claimed in independent claims 1, 5, 13, 17, and 21:

- a credit card having encoded information thereon that associates the cardholder with a plurality of clubs, merchants, or service providers for which automated charge transaction requests are initiated by the card provider;
- a card issuer database for storing information that identifies the plurality of clubs, merchants or service providers associated with the cardholder, and that further provides payment information for each associated club, merchant, or service provider;
- a card processor for performing the automated charge transaction requests which are for payments due by the cardholder to the clubs, merchants, or service providers in consideration of services or goods; and

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- the card issuer database further stores information of at least one partner that is affiliated with the plurality of clubs, merchants, or service providers.

Prior art does not disclose or suggest the unique combination of these features, as disclosed in applicant's claimed invention and stated in independent claims 1, 5, 13, 17, 21. Prior art does separately disclose these features; however, it would not have been obvious to combine the prior art to disclose applicants' claimed invention. Applicant's amendment makes the invention unique and distinct over prior art. Prior art of record includes:

- Fernandez-Holmann (U.S. Patent No. 5,787,404) that teaches a method and system for providing an investment fund, such as a long term investment fund which may be suitable for retirement purposes, comprising the steps of establishing a credit based account with a credit card issuer for the benefit of a credit card holder, providing an investment account with a financial institution for the benefit of the credit card holder, funding the investment account by the credit card issuer with a predetermined amount of money on a periodic basis, and charging an amount of money so funded against the credit based account of the credit card holder.
- Kolling et al. (U.S. Patent No. 5,920,847) that teaches a bill pay system wherein participating consumers pay bills to participating billers through a payment network operating according to preset rules. The participating consumers receive bills from participating billers (paper/mail bills, e-mail notices, implied bills for automatic debits) which indicate an amount, and a unique biller

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identification number. To authorize a remittance, a consumer transmits to its participating bank a bill pay order indicating a payment date, a payment amount, the consumer's account number with the biller, a source of funds and the biller's biller identification number, either directly or by reference to static data containing those data elements. Bank C then submits a payment message to a payment network, and the payment network, which assigns the biller reference numbers, forwards the payment message to the biller's bank.

- Pollin (U.S. Patent No. 6,041,315) that teaches a system and method of collecting payments uses an automated system to generate a draft, payable to the creditor and drawn on the payor's checking account, pursuant to the payor's authorization.

- Perazza (U.S. Patent No. 5,326,959) that teaches a computer-controlled funds processing and remittance processing system, for use by individual, business and other bank customers.

- Auriemma (U.S. Patent No. 5,513,102) that teaches Data processing methods for enhancing the value of a substantially conventional credit card so as to enhance a user's perception of the desirability of holding and using the card and encourage increased use of the card for its normal utility as a payment device.

- Reeder (U.S. Patent No. 6,014,636) that teaches a method for providing point-of-sale (POS) payment using interactive television (ITV) or the world wide web (WWW) by directly debiting a customer's bank account through electronic transfer of funds or by billing a customer's credit card account. The customer

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places an order for products or services on his ITV station, or through the WWW from his personal computer, and can make POS payment either by authorizing direct debit from his bank account or by authorizing a charge to his credit card account.

- Carlisle et al. (U.S. Patent No. 5,649,118) that teaches a single set of consumer items may be purchased by debiting any of a plurality of accounts stored on a smart card.

- Lacker, Jeffrey M.; "Stored value cards: costly private substitutes for government currency;" Economic Quarterly, v82, n3, p1(25); Summer 1996, that teaches stored value cards look like credit cards but are capable of storing monetary value.

- "A Store Card Issuer Looks for Lift From Electronic Gift Certificates;" Credit Card News, p4; 01 February 1995, that teaches retailers are launching some innovative card spin-offs in their quest to set themselves apart from the competition.

- Hotchkiss, D Anne; "ATMs at the head of their class;" Bank Marketing, v29n3, pp:26-32; March 1997, that teaches The Comptroller of the Currency has authorized banks to offer theater and bus tickets, gift certificates, prepaid phone cards and similar products through ATMs.

- Kawan et al. (EP 0 959 440) that teaches a system and method for performing and settling an electronic scrip transaction between a merchant and a member includes a database storing accounts for one or more participating merchants, scrip distributors, sponsoring organizations, and members.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson Jr. whose telephone number is (703) 306-5449. The examiner can normally be reached on 6:30 AM-3:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FT 
07/27/2004


Jeffrey A. Smith
Primary Examiner